Exhibits

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EXXON MOBIL CORPORATION,	§	
Opposer,	§	Opposition No. 120,519
v.	§	
DATAWORX B.V.	§	
Applicant.	§	

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Opposer, Exxon Mobil Corporation ("Opposer"), by and through its attorneys, brings this Motion for Summary Judgment pursuant to Fed. R. Civ. P. 56 and TBMP § 528.

INTRODUCTION

Dataworx B.V. ("Applicant") is a European company that has never done business in the United States. In Europe, Applicant is and always has been a distributor – nothing more, nothing less. Applicant does not manufacture or sell any product of its own. Rather, Applicant merely distributes the branded products of others. Applicant has followed this business model in Europe for several years. Yet now, without a shred of documentary evidence to support its positions, Applicant asserts not only that it intends to begin using the mark DEXXON in the United States, but that it also intends to suddenly switch horses and use DEXXON as a trademark for a long list of goods in its application. Because Applicant has utterly failed to demonstrate during discovery that it has the requisite bona fide intent to use the mark for these goods in the United States, its application should be rejected.

[illegible]

FACTUAL BACKGROUND

Applicant filed an intent-to-use trademark application, Serial No. 75/511,805, on July 1, 1998 for the mark DEXXON, covering "computers and computer peripherals; optical appliances and instruments, namely, optical disk readers; computer storage devices and media, namely, blank optical disks; blank audio disks; blank audio cassette tapes; blank re-writeable CD-ROM disks; head cleaning cartridges for computer storage devices and data storage equipment; blank computer hard disks; removable disks and tape backup drives for computers; blank digital linear tape cartridges; blank 4 MM and 8 MM computer storage tapes; blank removable three and half inch and five and quarter inch floppy disks" in International Class 9.

According to the Applicant's web site, http://www.dexxon.com, it is a "Pan European distributor of storage media, devices and accessories and solutions," distributing products throughout Europe and adjacent markets, such as Africa. Various pages of the web site, to which Applicant has referred in response to discovery requests, are attached to the Declaration of Eric R. Olson in Support of Opposer's Motion for Summary Judgment ("Exhibit 1") at Tab A. A review of Applicant's price list indicates that Applicant does not manufacture or sell any products of its own, but only wholesales many well-known brands of computer products such as Cannon, Fuji, Compaq, Maxell, Hewlett-Packard, TDK, Sony, IBM, and others. Exhibit 1 at Tab B. Applicant has stated that it does not currently "sell used, modified, or 'aftermarket' products ... in the United States." Applicant's Resp. to Interrog. No. 43 (Exhibit 1 at Tab E). Applicant has also stated that it does not have any plans to sell any products beyond those it currently sells. Applicant's Resp. to Interrog. No. 4 (Exhibit 1 at Tab C).

APPLICABLE LEGAL STANDARD

Summary judgment benefits the judicial system because it is a "method of disposition designed to secure the just, speedy and inexpensive determination of every action," *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1652 (Fed. Cir. 1987) (citing *Celotex v. Catrett*, 477 U.S. 317, 322 (1986)), and is proper when the pleadings and discovery show "that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *Celotex,* 477 U.S. at 322.

When moving for summary judgment, the burden does not fall on the movant to produce evidence that no genuine issue of material fact exists. *Sweats*, 833 F.2d at 1563. Rather, the moving party's burden is to "*point out* ... that there is an absence of evidence supporting the nonmoving party's case." *Id.* (emphasis added) (citing *Celotex*); *see also Kellogg Co. v. Pack'Em Enters. Inc.*, 951 F.2d 330, 333 (Fed. Cir. 1991). The burden then shifts to the nonmoving party who "must set forth specific facts showing that there is a genuine issue for trial." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986) (quoting Fed. R. Civ. P. 56(e)). Once that burden shifts, the nonmoving party cannot simply rest on its conclusory pleadings or reassert its previous allegations. *Pure Gold, Inc. v. Syntex, Inc.*, 739 F.2d 624, 626-27 (Fed. Cir. 1984). Instead, Rule 56(e) "requires the nonmoving party to go beyond the pleadings" to present "concrete evidence" supporting its position. *Celotex,* 477 U.S. at 324.

The motion for summary judgment will be granted "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). A factual dispute is genuine only if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 767 (Fed. Cir. 1993).

ARGUMENT

The Trademark Law Revision Act of 1988 reads in pertinent part, "A person who has a *bona fide intention, under circumstances showing the good faith of such person*, to use a trademark in commerce may request registration of its trademark on the principal register[.]" 15 U.S.C. 1051(b)(1) (2003) (emphasis added).

Elimination of "token use" was both a goal and justification for Congress's adoption of the intent-to-use provisions of the Trademark Law Revision Act of 1988. H. REP. NO. 100-1028, 100th Cong. 2d Sess. at 8-9 (1988) ("By permitting applicants to seek protection ... through an intent to use system, there should be no need for 'token use' of a mark simply to provide a basis for an application."). It would make no sense for Congress to abolish "token use," but allow it to be replaced with "token intent to use." Accordingly, the plain language of the statute requires more than a mere statement of intent to use by requiring a "bona fide" intention to use a mark in commerce.

> The use of the term "bona fide" is meant to eliminate ..."token use," *and to require, based on an objective view of the circumstances*, a good faith intention to eventually use the mark in a real and legitimate commercial sense.

Id. (emphasis added). This is a statutory prerequisite to registration that can not be waived by the Commissioner. *See In re Paul Wurth S.A.*, 21 U.S.P.Q. 2d 1631, 1633 (Comm'r Pat. & TM 1991).

The Board has ruled that "Applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's bona fide intention to use the mark in commerce." *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 U.S.P.Q. 2d 1351, 1355 (T.T.A.B. 1994); *See also, Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q. 2d 1503 (T.T.A.B. 1993). Applicant in this case, however, has provided nothing but a "mere statement of

subjective intention" to use the mark in the United States in response to numerous requests for something, indeed *anything*, more. For instance, Opposer asked Applicant the following Interrogatory:

> State whether you sell or intend to sell any products for which the brand name of the product is DEXXON, and if so, identify all such products.

Applicant's response to this Interrogatory stated:

> Applicant states that it does intend to sell products in the United States for which the brand name of the product is DEXXON, but it *does not currently have plans regarding specific items.*"

Applicant's Resp. to Interrog. No. 42 (Exhibit 1 at Tab E) (emphasis added). This is the very essence of a "subjective intent without more."

If Applicant had bona fide plans to use the mark in United States commerce for goods, one would expect to see some indication of this in product development plans, market research, documents reflecting early negotiations with necessary providers and shippers, pricing worksheets, even something as simple as printouts of web pages from soon-to-be competitor sites. Instead, Applicant has produced absolutely nothing to corroborate its alleged intent. For example, in a request for production, Opposer asked Applicant to:

> Produce all documents that refer to, relate to, or evidence your plans to use the mark DEXXON in the United States.

Applicant responded:

> Applicant states that it has not identified *any* responsive documents currently in its possession.

Applicant's Resp. to Req. for Prod. No. 24 (Exhibit 1 at Tab F) (emphasis added).

Beyond its claim in the application, Applicant does not have one shred of evidence that it intends to use the mark in the United States for any of the goods specified in the application.

Applicant's responses showing a lack of an intent to use and lack of evidence of an intent to use have been repeated throughout the discovery process. Some key discovery responses are highlighted below. Pursuant to TBMP § 528.05(c), the relevant discovery responses are included in Exhibit 1 attached as Tabs C through G.

Answers to Interrogatories **(objections omitted)**

Interrogatory Number 25 (Exhibit 1 at Tab D):

- If you have not begun using the mark DEXXON in the United States, when do you intend to begin doing so?

  "Applicant states that it does not have a firm date on which it will begin to sell or offer to sell products and services in the United States."

Interrogatory Number 34 (Exhibit 1 at Tab D):

- If your response to Request for Admission No. 5 ["Admit that you do not have any documentary evidence showing that you currently intend to use the mark DEXXON in connection with the sale of goods in the United States."] is anything other than an unqualified admission, describe ... your grounds for denial and identify all documents supporting it.

  "Applicant identifies its executed U.S. Trademark application for the DEXXON mark."

Interrogatory Number 35 (Exhibit 1 at Tab D):

- If your response to Request for Admission 6 ["Admit that you do not have any documentary evidence showing that at the time you filed U.S. Trademark Application Serial No. 75/511,805 you intended to use the mark DEXXON in connection with the sale of goods in the United States."] is anything other than an unqualified admission, describe ... your grounds for denial and identify all documents supporting it.

  "Applicant identifies its executed U.S. Trademark application for the DEXXON mark."

Interrogatory Number 42 (Exhibit 1 at Tab E):

- State whether you sell or intend to sell any products for which the brand name of the product is DEXXON, and if so, identify all such products.

  "Applicant states that it does intend to sell products in the United States for which the brand name of the product is DEXXON, but it does not currently have plans regarding specific items."

Answers to Requests for Production

Request Number 22 (Exhibit 1 at Tab F):

- If your response to any of the Requests for Admission in Opposer's First Set of Requests for Admission [Including Request Number 6,[1] and other requests seeking admissions regarding Applicant's lack of intent to use the mark, all of which were denied] is anything other than an unqualified admission, produce all documents supporting your denial.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 24 (Exhibit 1 at Tab F):

- Produce all documents that refer to, relate to, or evidence your plans to use the mark DEXXON in the United States.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 26 (Exhibit 1 at Tab F):

- Produce all documents concerning future arrangements to sell products under the mark DEXXON in the United States.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 27 (Exhibit 1 at Tab F):

- Produce all documents that relate to, refer to, or constitute communications with third parties regarding your plans to use the mark DEXXON in the United States, including any contracts or agreements.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 28 (Exhibit 1 at Tab F):

- Produce all documents, if any, showing that you currently intend to use the mark DEXXON in connection with the sale of goods in the United States.

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[1] Request for Admission No. 6 reads, "Admit that you do not have any documentary evidence showing that at the time you filed U.S. Trademark Application Serial No. 75/511,805, you intended to use the mark DEXXON in connection with the sale of goods in the United States." RESPONSE: "Deny."

"Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 29 (Exhibit 1 at Tab F):

- Produce all documents, if any, showing that at the time you filed U.S. Trademark Application Serial No. 75/511,805, you intended to use the mark DEXXON in connection with the sale of goods in the United States.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 30 (Exhibit 1 at Tab G):

- If you denied or failed to give an unqualified admission to any of Opposer's Second Set of Requests for Admission, [regarding Applicant's use of, and intent to use DEXXON as a trademark] produce all documents supporting your response.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 31 (Exhibit 1 at Tab G):

- Produce documents sufficient to show all products manufactured by Applicant that Applicant sells or intends to sell under the mark DEXXON.

  "Applicant states that it has not identified any responsive documents currently in its possession."

Request Number 34 (Exhibit 1 at Tab G):

- "Produce all documents that relate to or evidence your sale of, or intent to sell, any products for which the brand name of the product is DEXXON."

  "Applicant states that its Trademark Application for the DEXXON mark (Serial No. 75/511,805) is evidence of its intent to sell the products in the United States under the DEXXON mark."

As noted above, Applicant's "mere statement of subjective intention" is "insufficient to establish applicant's bona fide intention to use the mark in commerce." *Lane Ltd.*, 33 U.S.P.Q. 2d at 1355. In *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q. 2d 1503, 1507 (T.T.A.B. 1993) the Board held that "absent other facts which adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent

to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b)." The only thing Applicant has offered is the bare assertion in its application that it intends to use the mark in the United States. The numerous discovery requests above should have elicited whatever documentary evidence existed to demonstrate applicant's intent. Based on Applicant's answers, there simply is no documentary evidence whatsoever.

Furthermore, unlike *Commodore*, there are no other facts to explain or outweigh Applicant's failure to produce any documentary evidence regarding its intent to use. To the contrary, the other facts in this case corroborate the Applicant's *lack* of an intent to use the mark for the specified goods. Applicant is a distributor and wholesaler of computer related products in Europe and its adjacent markets. When asked to "[d]escribe all goods and services actually sold or offered for sale by Applicant under the DEXXON mark[,]" the Applicant responded, "Applicant states that the DEXXON mark is used in connection *with supplying* data media and storage products." Applicant's Resp. to Interrog. No. 3 (Exhibit 1 at Tab C) (emphasis added) (objections omitted). Applicant's website (*see* Exhibit 1 at Tab A) and brochures (*e.g.*, Exhibit 1 at Tab B) confirm its role as merely a distributor of others' branded products. Applicant does not manufacture or sell any of its own products, and there is no reason to believe that Applicant would suddenly change roles and begin manufacturing goods for sale in the U.S. market when it does not do so in its established trading area.

"[T]he determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances." *Lane* 33 U.S.P.Q. 2d at 1355. For the Board to accept the incredulous claim that Applicant could have a

bona fide intent to use the mark in commerce in the United States for the specified goods without any shred of documentary evidence, it would have to believe that Applicant would suddenly reverse roles and begin selling its own branded products in the United States. What is more, a finding of bona fide intent would require the Board to accept that Applicant would make this fundamental change without any evidence of it whatsoever. Such a finding simply can not be considered a "fair, objective determination based on all the circumstances."

CONCLUSION

Applicant has never used DEXXON as a trademark for goods in connection with its distributorship business in Europe, and, particularly in the absence of any documentary evidence to the contrary, there is no reason to believe it will suddenly do so in the United States. Under these circumstances, Applicant's complete failure to come forward with supporting documentary evidence compels the conclusion that Applicant has no bona fide intent to use the mark in commerce for the goods specified in the application. For these reasons, Opposer respectfully asks the Board to grant summary judgment in its favor and deny registration of Applicant's Trademark Application Serial No. 75/511,805 for the mark DEXXON.

DATED: September 10, 2003

Respectfully submitted,

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the OPPOSER'S MOTION FOR SUMMARY JUDGMENT has been served via First Class Mail, postage prepaid to counsel for Applicant at the address below, on this the 10th day of September, 2003:

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